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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/996,420	11/29/2001	Stephen J. Benkovic	00-387-J	2558

20306 7590 11/09/2004

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EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 11/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/996,420	<b>Applicant(s)</b> BENKOVIC ET AL.	
	<b>Examiner</b> MY-CHAU T TRAN	<b>Art Unit</b> 1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 3-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>SEE OFFICE ACTION</u> . | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

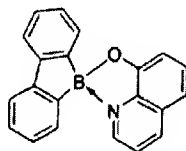
### *Status of Claims*

1. Applicant's response filed 8/24/2004 is acknowledged and entered.
2. Claims 1-9 are pending.

### *Election/Restrictions*

3. Applicant's election of Group I (Claims 1-2) in the reply filed on 8/24/2004 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
4. Claims 3-9 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to ***nonelected inventions***, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 8/24/2004.
5. Applicant has elected the following species for the elected invention (Claims 1-2):

The elected compound is 8-(5*H*-dibenzo[*b,d*]borol-5-yloxy)quinoline, which has the following structure:



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***Priority***

6. This application claims priority to a provisional application 60/250,202 filed 11/30/2000.

***Information Disclosure Statement***

7. The information disclosure statements (IDS) submitted by applicant filed on 9/25/2002, 6/13/2002, and 6/27/2003 are acknowledged and considered as noted on PTO-1449.

***Oath/Declaration***

8. The oath or declaration is missing.

A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required. Additionally, it is noted that the Notice to File Missing Parts of Application, mailed March 27, 2002, has informed applicant of the missing oath or declaration.

9. Please note: Applicant's *specifically* elected species that is 8-(5H-dibenzo[b, d]borol-5-yloxy)quinoline (see paragraph 5 above) was searched and was not found in the prior art. Also, see MPEP § 803.02 (emphasis added):

On the other hand, should no prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended. If prior art is then found that anticipates or renders obvious the Markush-type claim with respect to a nonelected species, the Markush-type claim shall be rejected and claims to the nonelected species held withdrawn from further consideration. ***The prior art search, however, will not be extended unnecessarily to cover all nonelected species.*** Should applicant, in response to this rejection of the Markush-type claim, overcome the rejection, as by amending the Markush-type claim to exclude the species anticipated or rendered obvious by the prior art, the amended Markush-type claim will be reexamined. The prior art search will be extended to the extent necessary to determine patentability of the Markush-type claim. In the event prior art is found during the reexamination that anticipates or renders obvious the amended Markush-type claim, the claim will be rejected and the action made final. Amendments submitted after the final rejection further restricting the scope of the claim may be denied entry.

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Thus, the search was expanded to non-elected species, which *were* found in the prior art. (See rejections below).

***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (US Patent 5,348,947).

Patel disclose the structure of the presently claimed compound (col. 1, lines 20-68; col. 2, line 25 to col. 4, line 21). For example the compound of Patel wherein X and Y are alkyl, A is O, i.e. oxygen, R<sub>5</sub> and R<sub>4</sub> are H, and R, R<sub>1</sub>, R<sub>2</sub>, R<sub>3</sub> are H would read on claimed compound wherein Ar<sup>1</sup> and Ar<sup>2</sup> are substituted aryl, W is O, R<sup>a</sup>, R<sup>b</sup> are the same and are lower alkyl, and R<sup>c</sup>, and R<sup>c</sup> are the same and are aryl. Thus the compound of Patel anticipates the presently claimed compound.

12. Claims 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Patel (US Patent 5,348,948).

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Patel disclosed the structure of the di(4-chlorophenyl)borinic acid 8-hydroxyquinoline ester, which is claimed in claim 2, (col. 1, line 49 to col. 2, line 14). Therefore the compound of Patel anticipates the presently claimed compound.

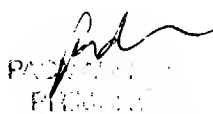
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MY-CHAU T TRAN whose telephone number is 571-272-0810. The examiner can normally be reached on Mon.: 8:00-2:30; Tues.-Thurs.: 7:30-5:00; Fri.: 8:00-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

mct  
November 5, 2004



My-Chau T. Tran  
Examiner